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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,517

10/07/2005

Hiroshi Sekiya

4414.P0684US

2391

23474 7590 11/03/2008  
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EXAMINER

HALPERN, MARK

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

11/03/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/552,517	<b>Applicant(s)</b> SEKIYA, HIROSHI	
	<b>Examiner</b> Mark Halpern	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 20, 22, 23 and 25-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-10, 22 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20 and 25-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1) Acknowledgement is made of Amendment received 9/5/2008. Claim 20 is amended, claims 11-19, 21, 24 are cancelled, and new claims 25-36 are offered for consideration.

Claims 1-10, 22-23 are withdrawn, claims 20, 25-36 are under review.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2) Claims 25-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 25-32 are not complete in that there appears to be word(s) or phases missing in the claims. The claims are not grammatically correct.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3) Claims 25, 28 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kuroda (JP 7-292382).

Kuroda discloses a contamination prevention agent made of mineral oil in emulsion (Abstract). The agent is used in paper machine drying process (Title, entire document). The claims are considered product-by-process claims since the claimed agent is obtained by an emulsifying process.

In the event any differences can be shown for the product of the product-by-process claims 25, 28, as opposed to the product taught by the reference Kuroda, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results; see also *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985).

4) Claims 20, 26-27, 29-30, 33-36, are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kuroda.

Kuroda discloses a contamination prevention agent used in paper machine drying process (Title, entire document). The release agent includes ampholyte copolymers since the agent is a copolymer that includes cationic

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monomer having ethylene double bond and anionic monomer having ethylene double bond, as for example, disclosed in paragraphs [0011]-[0015]. The claims are considered product-by-process claims since the claimed agent is obtained by polymerizing mixture of cationic monomer having ethylene double bond and anionic monomer having ethylene double bond.

In the event any differences can be shown for the product of the product-by-process claims 20, 26-27, 29-30, 33-36, as opposed to the product taught by the reference Kuroda, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results; see also *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985).

5) Claims 20, 26-27, 29-30, 33-36, are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Glover (5,658,374).

Glover discloses a release agent wherein the main component is an oil emulsion. The components of the emulsion are disclosed (col. 3, line 42 to col. 5, line 26). The release agent includes ampholyte copolymers since the agent includes cationic ethylene compounds and anionic and nonionic ethylene compounds. The claims are considered product-by-process claims since the claimed agent is obtained by polymerizing a mixture of cationic monomer having ethylene double bond and anionic monomer having ethylene double bond.

In the event any differences can be shown for the product of the product-by-process claims 20, 26-27, 29-30, 33-36, as opposed to the product taught by

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the reference Glover, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results; see also *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985).

### ***Terminal Disclaimer***

6) The terminal disclaimer filed on 9/5/2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of patents resulting from applications 10/540,617, 10/501,303, 10/546,345, 10/522,648 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Response to Amendment***

7) Applicant's arguments with respect to pending claims have been considered but are moot in view of cancelled, amended and new claims under consideration.

8) Applicant's arguments filed 9/5/2008 have been fully considered but they are not persuasive.

Applicant alleges that the present claims do not recite emulsifying silicone oil.

Amended claims 25, 28 recite emulsifying a mineral oil.

### ***Conclusion***

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9) **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone no. is 571-272-1190.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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/Mark Halpern/  
Primary Examiner  
Art Unit 1791